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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,102	12/11/2000	Rosario Gemaro	YOR920000597US1(13879)	3899

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RICHARD L. CATANIA, ESQ.
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400 Garden City Plaza
Garden City, NY 11530

EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,102

Applicant(s)

GENNARO ET AL.

Examiner

Aravind K Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-14 are pending in the application.
2. Claims 1-14 have been rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Yacobi U.S. Patent No. 5,878,138.

As to claim 1, Yacobi discloses a method of providing anonymous digital cash [column 3, lines 5-17], the method comprising:

- providing an entity with a secure co-processor [column 4, lines 48-65];

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- a user establishing a secure channel to a program running on the coprocessor [column 4, lines 48-65];
- and the user sending a coin to be digitally signed to the coprocessor using any
- secure digital signature algorithm [column 9, lines 34-43].

As to claims 2, Yacobi discloses a method comprising the steps of:

- the processor providing a signature to authenticate [column 9, lines 34-43];
- the user using the coin for payment to a merchant [column 5, lines 44-56];
- and the merchant returning the signed coin to the entity for credit to an account of the merchant [column 12 line 65 to column 13 line 13].

4. Claims 3-5, 7-9 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook et al U.S. Patent No. 6,675,153 B1.

As to claims 3, 7 and 11, Cook et al discloses a method of creating and managing electronic cash, comprising the steps:

- a customer communicating to a secure cryptography generator an encryption scheme and a cash amount [column 7, lines 44-65];
- establishing a unit representing the cash amount [column 15, lines 24-40];
- signing the unit [column 15, lines 54-60];
- using the secure cryptography generator to encrypt the signed unit using the encryption scheme [column 15, lines 54-60];
- storing in a database the encrypted signed unit and a value for the unit [column 16, lines 10-23];
- transmitting the encrypted signed unit to the customer [column 16, lines 41-52];

- the customer decrypting the encrypted signed unit to obtain the signed unit; and using the signed unit as a payment [column 16 line 53 to column 17 line 6].

As to claims 4, 8 and 12, Cook et al discloses establishing an expiration date for the unit. Cook et al discloses storing the expiration date in the database [column 6, lines 29-53].

As to claims 5, 9 and 13, Cook et al discloses that the signing step includes the step of using the secure cryptography generator to sign the unit [column 6 line 65 to column 7 line 13].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Cook et al U.S. Patent No. 6,675,153 B1 as applied to claims 3, 7 and 11 above, and further in view of by Demytko U.S. Patent No. 5,627,893.

As to claims 6, 10 and 14, Cook et al does not teaches using digital signatures, as discussed above.

Cook et al does not teach that the signing step includes the step of signing the unit with a non-homomorphic signature.

Demytko teaches using non-homomorphic signature signatures [column 11, lines 22-27].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Cook et al so that the digital signatures used to sign the unit were non-homomorphic signatures.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Cook et al by the teaching of Demytko because it prevents signatures from being replicated.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
April 26, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100